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Huang Ming
P.O. Box 166-13
Taipei, Taiwan R.O.C.
AIR MAIL

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OFFICE OF PETITIONS

In re Application of
Huang Ming
Application No. 10/697,934
Filed: October 31, 2003
Attorney Docket No. BP3029-H47-P15

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed August 16, 2005, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." Extensions of time under 37 CFR 1.136(a) are permitted. No additional fee is required for filing a "Renewed Petition under 37 CFR 1.137(a)."

On March 31, 2004, the Office mailed a Notice of Allowance and Fee(s) Due and a Notice of Allowability, which set a three-month statutory period for reply. The Notice of Allowance indicated that applicant must submit a \$665.00 issue fee and a \$300.00 publication fee by June 30, 2004, to avoid abandonment. The Notice of Allowability required applicant to submit Corrected Drawings (as "replacement drawings") including changes required by the Examiner's Amendment attached to the Notice. Applicant did not submit a response to either Notice within the specified period for reply. Accordingly, the application became abandoned on July 1, 2004. A Notice of Abandonment was mailed on August 2, 2004.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in

compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

- (2) The petition fee as set forth in 37 CFR 1.17(l);
- (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and
- (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

This petition lacks items (1) and (3) above.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".¹ Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.²

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).³ Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.⁴

¹ 35 U.S.C. § 133.

² In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

³ See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

⁴ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

As to requirement (1):

As previously stated, on March 31, 2004, the Office mailed a Notice of Allowability requiring applicant to submit Corrected Drawings (as “replacement drawings”) including changes required by the Examiner’s Amendment attached to the Notice, within three months of the mailing date of that Notice. Upon a review of the record, it does not appear that applicant submitted a proper and timely response to the Notice of Allowability. With any renewed petition to revive, applicant must comply with the requirements set forth in the Notice of Allowability.

As to requirement (3):

It appears that applicant is asserting that the delay was unavoidable due to non-receipt of the Notice of Allowance and Notice of Allowability mailed on March 31, 2004. Applicant states that he submitted a change of correspondence with the USPTO in application No. 09/276,639, as early as January 7, 2004.

A review of the written record indicates that the Notice of Allowance and the Notice of Allowability were properly mailed to the address of record as it existed on March 31, 2004. Although applicant asserts that he submitted a change of correspondence address with the USPTO in another application as of January 7, 2004, the record indicates that applicant did not submit a change of correspondence address in this application until November 29, 2004, over eight months the mailing of the Notices. Therefore, it appears that applicant did not receive the Notice of Allowance and the Notice of Allowability because he failed to file a timely change of correspondence address with the USPTO.

The belated notification to the USPTO of a change of correspondence address does not constitute proper notification as to establish unavoidable delay. Applicant is responsible for promptly informing the Office of any change of address. The Office further notes that where an application becomes abandoned as a consequence of a change of correspondence address an adequate showing of “unavoidable” delay requires a showing that applicant exercised due care to promptly notify the Office of the change of address and file a timely notification of the change of address in the application at hand.⁵ Furthermore, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an “unavoidable” delay.⁶

Because applicant did not provide a sufficient showing that the delay was unavoidable within the meaning of 35 USC § 151 and 37 CFR 1.137(a), the petition is **dismissed**. In any renewed petition under 37 CFR 1.137(a), applicant must submit a thorough explanation, including any documentary evidence, to support a showing of unavoidable delay.

⁵ MPEP 711.03(c)(III)(C)(2)

⁶ See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm’r Pat. 130, 131 (1891).

Alternative Venue:

Applicant is encouraged to consider filing a petition pursuant to 37 CFR 1.137(b) on the basis of unintentional delay, instead of filing a renewed petition under 37 CFR 1.137(a). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The required reply to the Notice of Allowability as discussed above;
- (2) The petition fee as set forth in 37 CFR 1.17(m) (\$750.00 for a small entity);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

A copy of the form for filing a "Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" is enclosed for applicant's convenience.

On petition, applicant authorized the Office to charge the Deposit Account for a \$750.00 petition fee. The current small entity fee for filing a petition to revive an unavoidably abandoned application is \$250.00. Unfortunately, it appears that the Office mistakenly charged the Deposit Account for two petition fees, totaling \$1,500.00. If applicant desires to file a renewed petition to revive an unavoidably abandoned application, applicant may request a refund in the amount of \$1,250.00. However, if applicant chooses to file a "Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," the \$750.00 petition fee will be deducted from the amount the Office overcharged and applicant may request a refund of \$500.00. Any request for a refund must be made in writing to the following address:

Mail Stop 16
Director of the US Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

A copy of this decision should accompany applicant's request.

Further correspondence with respect to this matter should be addressed as follows:

By mail: **Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

By FAX: **(571) 273-8300
Attn: Office of Petitions**

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211. All other inquiries concerning either the examination procedures or status of the application should be directed to the examiner or the Technology Center.

Christina T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosures: Form PTO/SB/64 -"Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" and Privacy Act Statement